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09/924,952	08/09/2001	Charlton Clinton Tooke III	11963-002001	2009

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EXAMINER	
PASS, NATALIE	
ART UNIT	**PAPER NUMBER**
3626	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/924,952	TOOKE, CHARLTON CLINTON	
	Examiner	Art Unit	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *9 August 2001 and 21 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 9 August 2001 and the Preliminary Amendment filed 21 November 2003. Claims 1-42 are pending

Duplicate Claims Warning

2. Applicant is advised that should claim 31 be found allowable, claims 41 and 42 will be objected to under 37 CFR 1.75 as being substantial duplicates thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 4-13, 18, 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Deavers, U.S. Patent Number 6, 044, 352.

(A) As per claim 1, Deavers teaches a method of managing health care resources for a health care consumer, the method comprising:

inserting taxable resources into a health savings account (Deavers; column 2, lines 18-21, column 3, lines 50-56);

inserting nontaxable resources into the health savings account (Deavers; column 2, lines 18-21, column 3, lines 50-56); and

enabling the health care consumer to access the health savings account to reimburse a health care provider (Deavers; column 4, lines 39-42, column 6, lines 1-4).

(B) As per claims 4-12, Deavers teaches a method as analyzed and discussed in claim 1 above

wherein an employer of the health care consumer provides the taxable resources or the nontaxable resources (Deavers; column 2, lines 57-61);

further comprising enabling additional taxable resources and additional nontaxable resources to be inserted in the health savings account at a subsequent time (Deavers; column 4, lines 39-42);

further comprising enabling the health care consumer to insert additional resources into the health savings account when an amount of resources available in the health savings account is insufficient to reimburse the health care provider (Deavers; column 7, lines 65 to column 8, line 11);

wherein the health savings account includes a maximum expenditure limit (Deavers; column 4, lines 58-62);

further comprising enabling the health care consumer to provide additional resources for health care costs beyond the maximum expenditure limit (Deavers; column 4, lines 58-62);

further comprising enabling a party other than the health care consumer to provide additional resources for health care costs beyond the maximum expenditure limit (Deavers; column 4, lines 58-62);

wherein the party includes at least one of an employer and an insurance provider (Deavers; column 2, lines 57-61);

further comprising deducting resources for reimbursement above the maximum expenditure limit from the health savings account (Deavers; column 4, lines 58-62); and

wherein at least a portion of the health savings account is placed in an investment vehicle (Deavers; column 3, lines 50-53).

(C) Claim 13 differs from method claim 1 in that it recites a health savings account for a health care consumer, rather than a method for managing heath care resources for a health care consumer, in the preamble.

Apparatus claim 13 repeats the subject matter of claim 1 as a set of elements rather than a series of steps. As the underlying processes of claims 1 have been shown to be fully disclosed by the teachings of Deavers in the above rejection of claim 1, it is readily apparent that the system disclosed by Deavers includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

(D) As per claims 18, 20-22, Deavers teaches an account as analyzed and discussed in claim 13 above

wherein the online controller displays information describing a health care opportunity (Deavers; Figure 1E, column 5, lines 58-66);

further comprising a services database enabling the health care consumer to identify a health care opportunity (Deavers; column 5, lines 50-57, column 8, lines 6-12); and

wherein identifying a health care opportunity includes enabling the health care consumer to allocate resources for the health care opportunity (Deavers; column 4, lines 39-42, column 6, lines 1-4, column 7, lines 65 to column 8, line 11);

wherein the allocation device is structured and arranged to access one or more transaction parameters utilized by the allocation device to update information in the services database (Deavers; column 3, lines 34-42).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 26-27, 29, 31-33, 35, 37-38, 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Barber et al., U.S. Patent Number 4,858,121.

(A) Claim 26 differs from claim 1 in that it is a health care system that facilitates selection of a health care provider rather than a method of managing health care resources for a health care consumer.

As per claims 26-27, 29, Barber teaches a health care system comprising:

a first host structured and arranged to facilitate selection of a health care provider (Barber; Abstract, column 8, line 54 to column 9, line 2); and

a second host structured and arranged to manage an online health account (Barber; Abstract, column 3, lines 61-66);

wherein facilitating selection of the health care provider includes maintaining a services database (Barber; column 3, lines 41-59, column 6, lines 50-58); and

wherein facilitating selection of the health care provider includes updating the services database (Barber; column 7, lines 22-28).

(B) As per claims 31-33, 35, 37-38, 41-42, Barber teaches a health care system as analyzed in claim 26 above

wherein managing the online health account includes establishing the online health account (Barber; column 5, line 65 to column 6, line 9, column 9, lines 11-25);

wherein managing the online health account includes enabling access to the services database (Barber; column 3, lines 41-59, column 6, lines 50-58);

wherein managing the online health account includes populating a services database (Barber; column 7, lines 22-28);

wherein managing the online health account includes enabling transaction processing (Barber; column 6, lines 55-59);

wherein managing the online health account includes receiving funds (Barber; Abstract, column 3, lines 61-66); and

wherein managing the online health account includes allocating funds (Barber; Abstract, column 3, lines 61-66).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 2-3, 14-17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deavers, U.S. Patent Number 6, 044, 352 as applied to claims 1 and 13 above, and further in view of Barber et al., U.S. Patent Number 4,858,121.

(A) As per claim 2-3, Deavers teaches a method as analyzed and discussed in claim 1 above.

Although Deavers teaches electronic transfers of funds (Deavers; column 3, lines 53-56, column 7, line 65 to column 8, line 2), Deavers fails to explicitly disclose a method

wherein enabling the health care consumer to reimburse the health care provider includes enabling the health care consumer to direct reimbursements from an online health account and

further comprising enabling the online health account to display transaction information related health care that has been provided.

However, the above features are well-known in the art, as evidenced by Barber.

In particular, Barber teaches

wherein enabling the health care consumer to reimburse the health care provider includes enabling the health care consumer to direct reimbursements from an online health account (Barber; Abstract, column 3, lines 61-66) and

further comprising enabling the online health account to display transaction information related health care that has been provided (Barber; column 6, lines 55-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Deavers to include the above limitations, as taught by Barber, with the motivations of reducing delays between the time medical services were provided and when compensation was received , thus decreasing physicians' overhead, lowering medical costs to the consumer (Barber; column 1, 49-53).

(B) Apparatus claims 14, and 19 repeat the subject matter of claims 2, and 3, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 2 and 3 have been shown to be fully disclosed by the collective teachings of Deavers and

Barber in the above rejections of claims 2 and 3, it is readily apparent that the system disclosed collectively by Deavers and Barber includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 2 and 3, and incorporated herein.

(C) As per claims 15-17, Deavers and Barber teach an account as analyzed and discussed in claims 13 and 14 above

wherein the communications device includes a computing device (Deavers; column 1, lines 38-46, column 7, lines 59-67);

wherein the communications device includes a telephone (Deavers; Figure 1F, column 6, lines 44-47);

wherein the online controller enables a display of information in the taxable account or the nontaxable account (Barber; column 3, 59-66)

9. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deavers, U.S. Patent Number 6, 044, 352 as applied to claims 13 and 20 above, and further in view of Henley, U.S. Patent Application Publication Number 2002/0065758.

(A) As per claims 23-25, Deavers teaches an account as analyzed and discussed in claims 13 and 20 above.

Deavers fails to explicitly disclose an account

wherein the services database includes a quality assessment tool created from feedback of the health care consumer;

wherein the services database includes a directory of health care providers; and

further comprising enabling the health care consumer to search the directory of health care providers by cost, location, affiliation or quality.

However, the above features are well-known in the art, as evidenced by Henley.

In particular, Henley teaches

wherein the services database includes a quality assessment tool created from feedback of the health care consumer (Henley; paragraph [0037]);

wherein the services database includes a directory of health care providers (Henley; paragraph [0085]); and

further comprising enabling the health care consumer to search the directory of health care providers by cost, location, affiliation or quality (Henley; Abstract, paragraphs [0019] [0084]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the account of Deavers to include the above limitations, as taught by Henley, with the motivations of improving the quality of medical services provided to patients and other buyers of medical services (Henley; paragraph [0037]).

10. Claims 28, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al., U.S. Patent Number 4,858,121 in view of Henley, U.S. Patent Application Publication Number 2002/0065758.

(A) As per claims 28, 30, Barber teaches a system as analyzed and discussed in claim 26 above.

Barber fails to explicitly disclose a system

wherein facilitating selection of the health care provider includes soliciting feedback regarding the health care provider; and

wherein facilitating selection of the health care provider includes enabling the services database to be searched.

However, the above features are well-known in the art, as evidenced by Henley.

In particular, Henley teaches

a system wherein facilitating selection of the health care provider includes soliciting feedback regarding the health care provider (Henley; paragraph [0113]); and

wherein facilitating selection of the health care provider includes enabling the services database to be searched (Henley; Abstract, paragraph [0084]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the account of Barber to include the above limitations, as taught by Henley, with the motivations of providing a more convenient mechanism for identifying and contacting a high quality, qualified medical service provider that will provide a desired medical service at the desired quality, time, location and price (Henley; paragraph [0023]).

11. Claims 34, 36, 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al., U.S. Patent Number 4,858,121 as applied to claim 26 above and further in view of Deavers, U.S. Patent Number 6, 044, 352.

(A) As per claims 34, 36, 39-40, Barber teaches a system as analyzed and discussed in claim 26 above.

Barber fails to explicitly disclose a system

wherein managing the online health account includes opening a health savings account;

wherein managing the online health account includes setting the health savings account preferences;

wherein managing the online health account includes depositing funds into the health savings account; and

wherein managing the online health account includes withdrawing funds from the health savings account.

However, the above features are well-known in the art, as evidenced by Deavers.

In particular, Deavers teaches a system

wherein managing the online health account includes opening a health savings account (Deavers; Figure 1A, Item 14, column 2, line 52 to column 3, line 10);

wherein managing the online health account includes setting the health savings account preferences (Deavers; column 7, lines 44-59);

wherein managing the online health account includes depositing funds into the health savings account (Deavers; column 2, line 52 to column 3, line 10); and

wherein managing the online health account includes withdrawing funds from the health savings account (Deavers; column 2, line 52 to column 3, line 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the account of Barber to include the above limitations, as taught by Deavers, with the motivations of permitting individuals, families and defined groups, such as employers on behalf of their employees, or affiliation groups on behalf of their members, to establish medical savings accounts in an efficient and economical fashion (Deavers; column 1, lines 11-15).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Mayer et al., U.S. Patent Application Number 2002/0010597, Ramsaroop, U.S. Patent Application Number 2001/0027402, Kenna, et al., U.S. Patent Number 6, 108, 641, Javors, U.S. Patent Application Number 2002/0152097, Wizig, U.S. Patent Number 6, 735, 569, and Kahn et al., U.S. Patent Number 6, 401, 079 teach the environment of health savings accounts for future medical expenses.

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. After Final communications should be labeled "Box AF."

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Natalie A. Pass

February 1, 2006

C. LUKE GILLIGAN
PATENT EXAMINER